

### **REMARKS/ARGUMENTS**

Applicant has carefully reviewed and considered the Office Action mailed on December 18, 2003, and the references cited therewith.

Claims 14, 17 and 22 are amended; as a result, claims 1-24 are now pending in this application.

#### **§112 Rejection of the Claims**

Claims 18-21 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, claims 18-19 were rejected because the claim language "said determining step" lacked antecedent basis. Additionally, claims 20-21 were rejected because they depend from rejected claims 18-19.

Claims 18-21 are depended claims on independent claim 17. Applicant has amended independent claim 17 in order to provide antecedent basis for "said determining step" recited in claims 18-19. Applicant respectfully requests reconsideration and withdrawal of the 112 rejection for claims 18-21 in view of amended claim 17.

#### **§102 Rejection of the Claims**

Claims 1, 3-6, 10, 14, 15, 17, 18, 23, and 24 were rejected under 35 USC § 102(b) as being anticipated by Kurata, et al. (U.S. Patent No. 4,518,999).

In the office action dated December 18, 2003 (hereinafter "Office Action"), the Examiner cited col. 4, lines 48-54 of the Kurata reference as describing "a second set of slidable members." The Examiner also cited col 4, lines 48-61, Figs. 3 and 4, col 2, line 55 – col. 3, line 38 as describing "said second set of slidable members defining coordinates of the scan area along said second axis" as recited in Applicant's independent claim 1. Further, the Examiner cited col. 3, line 39 to col. 4, line 47 as describing generating signals indicative of said coordinates.

Specifically, the Examiner cited the term "another mechanism" as describing a second set of slidable members that designates a part or area of the document in the X-direction.

Kurata appears to describe position designating cursors that can be positioned at the front of a copier and movable in a Y-direction, or along the Y-axis. The Applicant was unable to find anywhere in the Kurata reference a second set of slidable members as recited in Applicant's independent claim 1. The "another mechanism" described in the Kurata reference does not describe a second set of slidable members. The "another mechanism" described by the Kurata reference appears to describe a single part at which scanning in the X direction starts. The Kurata reference states: "Then the displacing of the reading unit in the X-direction is initiated so that the reading of original document from a part designated with respect to this direction by another mechanism is performed." See col. 4, lines 50-54.

Further, The Examiner states that "from a part" describes a set of slidable members on an axis defining coordinates on the axis. The Applicant respectfully submits that the phrase "from a part designated with respect to this direction by another mechanism" does not describe a set of slidable members on an axis, defining coordinates along that axis. That is, the scanning in the X-direction described by the Kurata reference appears to describe, if anything, scanning "from a part." Scanning "from a part" does not describe a set of slidable members on an axis defining coordinates along that axis.

In contrast, Applicant's independent claim 1 recites:

"a first set of slidable members located on a first axis adjacent the scanable surface for defining coordinates of the scan area along said first axis thereof and generating signals indicative of said coordinates;

a second set of slidable members located on a second axis generally perpendicular to said first axis, said second axis being adjacent the scanable surface, said second set of slidable members defining coordinates of the scan area along said second axis thereof and generating signals indicative of said coordinates."

Applicant's independent claim 1 provides for two sets of slidable members. One set is positioned along a first axis, i.e., a Y-axis, and the second set is positioned on a second axis perpendicular to the first axis, i.e., an X-axis. Thus, as described by the Applicant in independent claim 1, a set of slidable members defines a set of coordinates on the X-axis.

Additionally, the Examiner cited col. 3, line 39 to col. 4, line 47 of the Kurata reference as describing "generating signals indicative of said coordinates."

Kurata appears to describe electrical signals that correspond to positional data in the Y-direction only. The Applicant was unable to find in the Kurata reference a description of electrical signals that correspond to a second direction or second set of coordinates, i.e., signals indicating positional data in an X-direction.

In contrast, Applicant's independent claim 1 recites: "said second set of slidable members defining coordinates of the scan area along said second axis thereof and generating signals indicative of said coordinates." That is, the Applicant's independent claim 1 describes defining coordinates on a first and second axis and generating signals from those coordinates. Moreover, such coordinates are defined by two sets of slidable members; a first set on a Y-axis and a second set on an X-axis.

To summarize, the Examiner cited Kurata as describing sets of slidable members on a second axis, or X-direction. Further, the Examiner cited Kurata as defining sets of coordinates in an X-direction. Finally, the Examiner cited Kurata as generating electrical signals from the set of slidable members in the X-direction. The Applicant respectfully submits that Kurata does not describe a set of slidable members on a second axis, or X-direction, nor does the Kurata reference define a set of slidable members that define coordinates on an X-axis, or X-direction, and finally, Kurata does not describe the generation of electrical signals indicative of the set of coordinates on the X-axis, or X-direction.

As such, each and every element of Applicant's independent claim 1 is not provided in the Kurata reference and thus, the reference does not support a 102 rejection. Accordingly, reconsideration and withdrawal of the 102 rejection for independent claim 1, as well as those claims which depend therefrom, is respectfully requested.

In the Office Action, the Examiner cited the Kurata reference as describing each and every limitation of Applicant's independent claim 14. Specifically, the Examiner stated that the position designating cursors of the Kurata reference define a scanning area, and the controller inherently determines whether the defined scan area is the entire scan area or just a portion of the entire scan area and controls the scanning depending on the result.

As indicated above in independent claim 1, the Kurata reference appears to describe producing positional data with respect to the Y direction only. *See* col. 3, line 59 and line 68, and col. 4, line 37.

In contrast, Applicant's independent claim 14, as amended, recites "defining a scan area that includes at least two X coordinates and at least two Y coordinates." That is, Applicant's independent claim 14, as amended, defines a scan area that includes sets of coordinates on an X-axis and sets of coordinates on a Y-axis.

As such, each and every element of Applicant's independent claim 14 is not provided in the Kurata reference and thus, the reference does not support a 102 rejection. Accordingly, reconsideration and withdrawal of the 102 rejection for independent claim 14, as well as those claims which depend therefrom, is respectfully requested.

In the Office Action, the Examiner cited the Kurata reference as describing each and every limitation of Applicant's independent claim 17. Specifically, in the Office Action, the Examiner stated that it is inherent that the plurality of cursors is selectively positioned to define the scan area, depending on the user's desire on the size or dimension of the scan area to be scanned.

As discussed above in independent claims 1 and 14, the Kurata reference does not appear to describe a plurality of cursors to define a scan area that includes sets of coordinates on an X-axis and sets of coordinates on a Y-axis. The Kurata reference appears to describe position designating cursors on a Y-axis.

In contrast, Applicant's independent claim 17, as amended, recites:

“A method for scanning a scan area within a scanable surface of a scanning device using a positioning apparatus having a plurality of members for defining a plurality of X and Y coordinates of the scan area, said method comprising the steps of:

positioning selected ones of said plurality of members to define said plurality of X and Y coordinates of the scan area;

determining whether said scan area is contained entirely within the scanable surface; and

scanning the scan area.”

Applicant's independent claim 17 recites positioning selected ones of said plurality of members to define a plurality of X and Y coordinates of the scan area. Thus, the coordinates defined include sets of coordinates on a Y-axis and sets of coordinates on an X-axis.

As such, each and every element of Applicant's independent claim 17 is not provided in the Kurata reference and thus, the reference does not support a 102 rejection. Accordingly, reconsideration and withdrawal of the 102 rejection for independent claim 17, as amended, as well as those claims which depend therefrom, is respectfully requested.

#### §103 Rejection of the Claims

Claim 22 was rejected under 35 USC § 103(a) as being unpatentable over Kurata, et al. (U.S. Patent No. 4,518,999) in view of known art.

For the reasons presented above, Applicant believes independent claim 17 is allowable. Claim 22 is dependent on allowable independent claim 17. Accordingly, reconsideration and withdrawal of the 103 rejection for claim 22 is respectfully requested.

#### Allowable Subject Matter

Applicant notes with appreciation the allowance of claims 11-13.

Claims 2, 7-9, and 16 were objected to as being dependent upon a rejected base claims, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

For the reasons presented above, Applicant believes that independent claim 1 is allowable. Claims 2 and 7-9 depend from allowable independent claim 1. As such, claims 2 and 7-9 are now allowable.

For the reasons presented above, Applicant believes that independent claim 14 is allowable. Claim 16 depends from allowable independent claim 14. As such, claim 16 is now allowable.

Claims 19-21 were indicated to be allowable if rewritten to overcome the rejection(s) under 35 USC § 112, second paragraph, set forth in the Office Action to include all of the limitations of the base claim and any intervening claims.

For the reasons presented above, Applicant believes that independent claim 17, as amended, is allowable. Claims 19-21 depend from allowable independent claim 17. As such, claims 19-21 are now allowable.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (360) 212-8052 to facilitate prosecution of this matter.

If necessary, at any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

**CERTIFICATE UNDER 37 CFR §1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: **MS NON-FEE AMENDMENT** Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 18<sup>th</sup> day of March, 2004.

Sarah L. Reinhard  
Name

Sarah L. Reinhard  
Signature

Respectfully Submitted,  
Robert Seseck, et al.

By their Representatives,  
E.J. BROOKS & ASSOCIATES, PLLC  
1221 Nicollet Avenue, Suite 500  
Minneapolis, MN 55403

By: [Signature]  
Edward J. Brooks III  
Reg. No. 40,925

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